

Appln. No. 10/020,923

New Attorney Docket No.: 8109.003.USDV

d.) Remarks

Applicant has canceled claim 32, amended claims 11 and 29, and added new claims 33-36. Support for these amendments and new claims can be found throughout the specification (see pages 6-9) and also in the canceled and/or withdrawn claims. No new matter or new issues are presented with these amendments. Therefore, claims 11, 29-31 and 33-36 presently pending.

Remarks Regarding 35 U.S.C. § 103(a)

Claims 11 and 29-32 stand rejected, under 35 U.S.C. § 103(a), as allegedly obvious over Shih et al. (U.S. Patent No. 4,026,767) in view of Harlow and Lane. Applicant respectfully traverses this rejection.

According to the Examiner's comments in the Office Action, Applicant's arguments are directed to aspects of the invention which are not claimed. In particular, the Examiner alleges that a shorter time in which the method is performed is not claimed and, further, a shorter time is simple optimization. Further, the Examiner notes that, although neither Harlow nor Lane recite a teaching of the use of formazan, formazan is also not recited in Applicant's claims and, thus, there can be no teaching against. Applicant respectfully disagrees on both points.

With respect to the timing issue, Applicant respectfully asserts that the time period in which an assay is performed is indeed critical. This is well known to those skilled in the art and an obvious advantage in this industry. But more importantly, Applicant respectfully asserts that the instant invention has reduced the time period "and" at the same time, increased overall sensitivity of the procedure. As is clear to those skilled in art, having both shorter times and increased sensitivity are critical aspects of this technology (see also specification, pages 1-5 and 7-10). To make this aspect clear, Applicant has amended claim 11 to incorporate the time period of claim 32, and correspondingly 2. No assay with an increased sensitivity that can be performed within an eight hour time period is disclosed or suggested in Shih in combination with the cited references.

With respect to the use of formazan, Applicant respectfully notes that the issue is not whether the use of formazan is recited in the instant claims, but rather that Harlow and Lane

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"teach against" the use of formazan. To be a proper teaching against, it is sufficient that the use of formazan is encompassed within the subject matter of the instant claims. It is not necessary that formazan be expressly recited. Thus, Applicant respectfully asserts that, as admitted by the Examiner, Harlow and Lane teach against Applicant's claimed invention and that such teaching against is clear to those skilled in the art.

For at least these reasons, Applicant maintains that the rejection is moot. Thus, applicant respectfully requests that the rejection of claims 11 and 29-32, under 35 U.S.C. § 103(a), be withdrawn.

Remarks Regarding 35 U.S.C. § 112, second paragraph

Claims 11 and 29-32 stand rejected, under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicant respectfully traverses this rejection.

In the office action, the Examiner alleges that there is no correlation that detecting the viability marker is indicative of detecting the bacteria and suggests that detecting the bacteria be included in detecting the reporter-primary antibody marker. Applicant has amended the claim as suggested by the Examiner and this aspect of the rejection is moot.

The Examiner also alleges that claim 29 is unclear in what microorganisms are being referred to. Applicant has amended the claim as suggested by the Examiner and this aspect of the rejection is also moot.

Thus, the rejection of claims 11 and 29-32, under 35 U.S.C. § 112, second paragraph, is moot.

Remarks Regarding Prior Restriction Requirement

Applicant has reviewed the claims and believes that no additional search is required to be conducted for the Examiner to include the withdrawn claims into this case. Applicant respectfully requests that the Examiner reconsider the earlier Restriction Requirement and re-join

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the withdrawn claims. If the Examiner maintains the Restriction and otherwise allows the application, Applicant is willing to cancel the withdrawn claims. Please telephone the undersigned to obtain authorization for any such amendment.

Conclusion

If there are any additional fees due with the filing of this Amendment, including any additional fees for a further extension of time, not herein accounted for, applicant respectfully requests that extension and also requests that any and all fees due be charged to Deposit Account No. 14-1437 referencing Attorney Docket No. 8109.003.USDV.

Respectfully submitted,
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By


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